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JOHNS MANVILLE
IP Department
10100 W Ute Avenue
Littleton, Colorado 80127
(303) 978-2000

Case Docket No. 7189
Date: January 2, 2008

Mail Stop Appeals - Patents
COMMISSIONER OF PATENTS
PO Box 1450
Alexandria, VA 22313-1450

Re: Application of: Wirycz et al
Serial No.: 09/996,454
Filed: November 20, 2001
For: DESIGN EFFECT FIBERGLASS WALLCOVERINGS

Art Unit: 1771
Examiner: GOFMAN, Anna

Transmitted herewith is/are the following document(s) related to the above-identified application:

- ☐ Notice of Appeal
☒ Reply Brief (2 pages)
☐ Request for Oral Hearing

Please extend the time for filing the Notice of Appeal _____ () month to _____

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Notice of Appeal	\$510.00	
Appeal Brief	\$510.00	
Request for Oral Hearing	\$1030.00	
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Robert D. Touslee
Registration No. 34,032
(303) 978-3927
Customer No. 29602

[Signature]
Attorney

Attorney Docket No. JM 7189**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of)	MAIL STOP APPEAL BRIEF -
Thomas WIRYCZ et al.)	PATENTS
Application No.: 09/996,454)	Group Art Unit: 1771
Filed: November 20, 2001)	Examiner: Anna Gofman
For: DESIGN EFFECT FIBERGLASS)	Confirmation No.: 2430
WALLCOVERINGS)	

**RECEIVED
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Examiner's Answer mailed December 10, 2007. In the Examiner's Answer, on pages 5-10, the Examiner presents a "Response to Argument" section. The Examiner's responses are addressed below.

The Examiner points out, "KSR forecloses the argument that specific teaching, suggestion, or motivation is required to support a finding of obviousness." As explained in the recently published U.S. Patent and Trademark Office examination guidelines, to reject a claim based on the rationale of "Use of Known Technique To Improve Similar Devices (Methods, or Products) in the Same Way",

Office personnel must resolve the *Graham* factual inquiries. Office personnel must then articulate the following:

- (1) a finding that the prior art contained a "base" device (method, or product) upon which the claimed invention can be seen as an "improvement;"
- (2) a finding that the prior art contained a "comparable" device (method, or product) that is not the same as the base device) that was improved in the same way as the claimed invention;
- (3) a finding that one of ordinary skill in the art could have applied the known "improvement" technique in the same way to the "base" device (method, or product) and the results would have been predictable to one of ordinary skill in the art; and

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Attorney Docket No. JM 7189
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(4) whatever additional findings based on the *Graham* factual inquiries may be necessary, in view of the facts of the case under consideration, to explain a conclusion of obviousness.

The rationale to support a conclusion that the claim would have been obvious is that a method of enhancing a particular class of devices (methods, or products) was made part of the ordinary capabilities of one skilled in the art based upon the teaching of such improvement in other situations. One of ordinary skill in the art would have been capable of applying this known method of enhancement to a "base" device (method, or product) in the prior art and the results would have been predictable to one of ordinary skill in the art. The Supreme Court in *KSR* noted that if the actual application of the technique would have been beyond the skill of one of ordinary skill in the art, then using the technique would not have been obvious. If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.

(Emphasis Added; 72 FR 57526, 57530-31).

Appellants respectfully submit that the image coating step of Melber or Schwartz did not make a method of enhancing the processing steps of Edlund part of the ordinary capabilities of one skilled in the art, as Edlund discloses that the application of paint to the glass yarn fabric product of Edlund results in *desired and selective* image paint effects in a *user selected* color. Thus, Edlund already provides a product that when applied to a wall and painted by a consumer displays a distinct and decorative image effect.

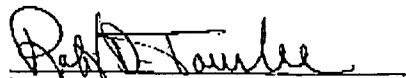
For the foregoing reasons, in combination with the arguments previously presented in the Appeal Brief, reversal of the rejections is respectfully requested.

Respectfully submitted,

JOHNS MANVILLE

Date January 2, 2008

By:


Robert D. Touslee
Registration No. 34,032

P. O. Box 625005
Littleton, CO 80162